

Appl. No. : 10/063,538
Filed : May 2, 2002

REMARKS

Applicants have cancelled Claims 1-3 without prejudice to, or disclaimer of, the subject matter contained therein. Applicants maintain that the cancellation of a claim makes no admission as to its patentability and reserve the right to pursue the subject matter of the cancelled claim in this or any other patent application.

Applicants have herein amended Claim 4 to be in independent form, and have amended Claims 5 and 12 to depend from Claim 4. Claim 13 is amended to replace the term "an epitope tag" with the term "a tag polypeptide." Applicants have added new Claims 14-17.

Support for the amendment to Claim 13 can be found, for example, at paragraph [0229]. Support for new Claims 14-17 can be found, for example, in the claims as originally filed and paragraphs [0336], [0362], [407], and Example 18 starting at paragraph [0529].

Applicants thank the Examiner for his review of the instant application and withdrawing the objection to the title and specification, and acceptance of the copy of the sequence listing. Applicants acknowledge the Examiner's withdrawal of the rejection of Claim 6 under 35 U.S.C. § 112, first paragraph, for lacking written description and enablement, the rejection of Claims 1-13 under 35 U.S.C. § 112, second paragraph, as being indefinite, and the rejection of Claims 1-10 under 35 U.S.C. § 102(b) as anticipated by Sulston *et al.*, Accession No. Q9UDNO or AAF19243.

Applicants note that the Examiner has not expressly maintained or withdrawn the rejection of Claims 12 and 13 under 35 U.S.C. § 103(a) as unpatentable over Sulston *et al.*, Accession No. Q9UDNO or AAF19243 in light of Jacobs *et al.* (U.S. Patent No. 5,965,397). Applicants note that in withdrawing the rejection of Claims 1-10 under 35 U.S.C. § 102(b) as anticipated by Sulston *et al.*, Accession No. Q9UDNO or AAF19243, the Examiner stated that "[a]lthough, Applicants claim to earlier priority is denied (August 24, 2000, based on PCT US00/23328) for reasons discussed in paragraph 9 above, because Applicants have disclosed the polypeptide of the instant invention previously in Figures 1 and 2A-C in 601097954 (without utility and enablement) the rejection is withdrawn. Sulston *et al.* disclosed only the amino acid without utility. Therefore, the rejection of claims 1-10 as being anticipated by Sulston *et al.* is withdrawn." Office Action at 19. Applicants respectfully submit that because neither of the Sulston references are available as prior art under 35 U.S.C. § 102, they are not available as prior

Appl. No. : 10/063,538
Filed : May 2, 2002

art under 35 U.S.C. § 103(a), and the rejection of Claims 12 and 13 should be formally withdrawn.

The rejections of the presently pending claims are respectfully traversed. Claims 4-17 are presented for examination.

Priority

The PTO asserts that because the disclosure of PCT/US00/23328 is not enabling for the instant invention, the filing date of the present application is May 2, 2002.

Applicants have previously listed the priority information for the instant application in a Preliminary Amendment mailed September 3, 2002. Applicants submit that for the reasons stated below, the claimed polypeptides have a credible, substantial, and specific utility. The sequences of SEQ ID NOs: 33 and 34 were first disclosed in US Provisional Application 60/097954 filed 8/26/1998 in Figures 1 and 2. The data in Example 18 (Tumor Versus Normal Differential Tissue Expression Distribution), relied on in part for the utility of the claimed nucleic acids, were first disclosed in PCT Application PCT/US00/23328 filed 8/24/2000, on page 93, line 3, through page 96, line 35. Applicants maintain that the present application is entitled to at least the priority date of August 24, 2000.

Rejection Under 35 U.S.C. §101

The PTO maintains its rejection of Claims 1-13 under 35 U.S.C. § 101 as lacking utility for the reasons set forth in the previous Office Action. The PTO asserts that “[g]iven the increase in expressed message for PRO1277 in the normal esophageal or normal skin compared to esophageal tumor or melanoma tumor tissues; and the evidence provided by the current literature, it is clear that one skilled in the art would not assume that a more highly expressed [message] would directly correlate with increased polypeptide levels.” Office Action at 6. The PTO relies on Haynes *et al.*, Hu *et al.* and Chen *et al.* for the propositions that the literature cautions researchers against drawing conclusions based on small changes in transcript expression levels and that polypeptide levels cannot be accurately predicted from mRNA levels. Office Action at 5-6. The PTO argues that further research is required to determine the role of PRO1277 in cancer, making the asserted utility not substantial. Office Action at 6-7. The PTO

Appl. No. : 10/063,538
Filed : May 2, 2002

also states that declarations submitted with Applicants' previous response are insufficient to overcome the rejection.

Utility – Legal Standard

According to the Utility Examination Guidelines ("Utility Guidelines"), 66 Fed. Reg. 1092 (2001) an invention complies with the utility requirement of 35 U.S.C. § 101, if it has at least one asserted "specific, substantial, and credible utility" or a "well-established utility."

Under the Utility Guidelines, a utility is "specific" when it is particular to the subject matter claimed. For example, it is generally not enough to state that a nucleic acid is useful as a diagnostic tool without also identifying the condition that is to be diagnosed.

The requirement of "substantial utility" defines a "real world" use, and derives from the Supreme Court's holding in *Brenner v. Manson*, 383 U.S. 519, 534 (1966) stating that "The basic *quid pro quo* contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility." In explaining the "substantial utility" standard, M.P.E.P. § 2107.01 cautions, however, that Office personnel must be careful not to interpret the phrase "immediate benefit to the public" or similar formulations used in certain court decisions to mean that products or services based on the claimed invention must be "currently available" to the public in order to satisfy the utility requirement. "Rather, *any reasonable use that an applicant has identified for the invention that can be viewed as providing a public benefit should be accepted as sufficient*, at least with regard to defining a 'substantial' utility." (M.P.E.P. § 2107.01, emphasis added).

The mere consideration that further experimentation might be performed to more fully develop the claimed subject matter does not support a finding of lack of utility. M.P.E.P. § 2107.01 III cites *In re Brana*, 51 F.3d 1560, 1566, 34 U.S.P.Q.2d 1436 (Fed. Cir. 1995) in stating that "Usefulness in patent law ... necessarily includes the expectation of further research and development. The stage at which an invention in this field becomes useful is well before it is ready to be administered to humans." Further, "to violate § 101 the claimed device must be totally incapable of achieving a useful result." *Juicy Whip Inc. v. Orange Bang Inc.*, 51 U.S.P.Q.2d 1700 (Fed. Cir. 1999), citing *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571 (Fed. Cir. 1992).

Appl. No. : 10/063,538
Filed : May 2, 2002

Indeed, the Guidelines for Examination of Applications for Compliance With the Utility Requirement, set forth in M.P.E.P. § 2107 II(B)(1) gives the following instruction to patent examiners: "If the applicant has asserted that the claimed invention is useful for any particular practical purpose ... and the assertion would be considered credible by a person of ordinary skill in the art, do not impose a rejection based on lack of utility."

Finally, in assessing the credibility of the asserted utility, the M.P.E.P. states that "to overcome the presumption of truth that an assertion of utility by the applicant enjoys" the PTO must establish that it is "more likely than not that one of ordinary skill in the art would doubt (i.e., "question") the truth of the statement of utility." M.P.E.P. § 2107.02 III A. The M.P.E.P. cautions that:

Rejections under 35 U.S.C. 101 have been **rarely sustained** by federal courts. Generally speaking, **in these rare cases**, the 35 U.S.C. 101 rejection was sustained [] because the **applicant ... asserted a utility that could only be true if it violated a scientific principle, such as the second law of thermodynamics, or a law of nature, or was wholly inconsistent with contemporary knowledge in the art.** M.P.E.P. § 2107.02 III B., citing *In re Gazave*, 379 F.2d 973, 978, 154 U.S.P.Q. 92, 96 (CCPA 1967) (underline emphasis in original, bold emphasis added).

Utility need NOT be Proved to a Statistical Certainty – a Reasonable Correlation between the Evidence and the Asserted Utility is Sufficient

An Applicant's assertion of utility creates a presumption of utility that will be sufficient to satisfy the utility requirement of 35 U.S.C. § 101, "unless there is a reason for one skilled in the art to question the objective truth of the statement of utility or its scope." *In re Langer*, 503 F.2d 1380, 1391, 183 USPQ 288, 297 (CCPA 1974). *See, also In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980); *In re Irons*, 340 F.2d 974, 144 USPQ 351 (1965); *In re Sichert*, 566 F.2d 1154, 1159, 196 USPQ 209, 212-13 (CCPA 1977). Compliance with 35 U.S.C. § 101 is a question of fact. *Raytheon v. Roper*, 724 F.2d 951, 956, 220 USPQ 592, 596 (Fed. Cir. 1983) cert. denied, 469 US 835 (1984). The evidentiary standard to be used throughout *ex parte* examination in setting forth a rejection is a preponderance of the evidence, or "more likely than not" standard. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). This is stated explicitly in the M.P.E.P.:

Appl. No. : 10/063,538
Filed : May 2, 2002

[T]he applicant does not have to provide evidence sufficient to establish that an asserted utility is true “beyond a reasonable doubt.” **Nor must the applicant provide evidence such that it establishes an asserted utility as a matter of statistical certainty.** Instead, evidence will be sufficient if, considered as a whole, it leads a person of ordinary skill in the art to conclude that the asserted utility is more likely than not. M.P.E.P. at § 2107.02, part VII (2004) (underline emphasis in original, bold emphasis added, internal citations omitted).

The PTO has the initial burden to offer evidence “that one of ordinary skill in the art would reasonably doubt the asserted utility.” *In re Brana*, 51 F.3d 1560, 1566, 34 U.S.P.Q.2d 1436 (Fed. Cir. 1995). Only then does the burden shift to the Applicant to provide rebuttal evidence. *Id.* As stated in the M.P.E.P., such rebuttal evidence does not need to absolutely prove that the asserted utility is real. Rather, the evidence only needs to be reasonably indicative of the asserted utility.

In *Fujikawa v. Wattanasin*, 93 F.3d 1559, 39 U.S.P.Q.2d 1895 (Fed. Cir. 1996), the Court of Appeals for the Federal Circuit upheld a PTO decision that *in vitro* testing of a novel pharmaceutical compound was sufficient to establish practical utility, stating the following rule:

[T]esting is often required to establish practical utility. But the test results **need not absolutely prove** that the compound is pharmacologically active. All that is required is that the tests be “*reasonably* indicative of the desired [pharmacological] response.” In other words, there must be **a sufficient correlation** between the tests and an asserted pharmacological activity so as to convince those skilled in the art, **to a reasonable probability**, that the novel compound will exhibit the asserted pharmacological behavior.” *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1564, 39 U.S.P.Q.2d 1895 (Fed. Cir. 1996) (internal citations omitted, bold emphasis added, italics in original).

While the *Fujikawa* case was in the context of utility for pharmaceutical compounds, the principals stated by the Court are applicable in the instant case where the asserted utility is for a therapeutic and diagnostic use – utility does not have to be established to an absolute certainty, rather, the evidence must convince a person of skill in the art “to a reasonable probability.” In addition, the evidence need not be direct, so long as there is a “sufficient correlation” between the tests performed and the asserted utility.

The Court in *Fujikawa* relied in part on its decision in *Cross v. Iizuka*, 753 F.2d 1040, 224 U.S.P.Q. 739 (Fed. Cir. 1985). In *Cross*, the Appellant argued that basic *in vitro* tests conducted in cellular fractions did not establish a practical utility for the claimed compounds.

Appl. No. : 10/063,538
Filed : May 2, 2002

Appellant argued that more sophisticated *in vitro* tests using intact cells, or *in vivo* tests, were necessary to establish a practical utility. The Court in *Cross* rejected this argument, instead favoring the argument of the Appellee:

[I]n *vitro* results...are generally predictive of *in vivo* test results, i.e., there is a **reasonable correlation** therebetween. Were this not so, the testing procedures of the pharmaceutical industry would not be as they are. [Appellee] has not urged, and rightly so, that there is an invariable exact correlation between *in vitro* test results and *in vivo* test results. Rather, [Appellee's] position is that successful *in vitro* testing for a particular pharmacological activity establishes a **significant probability** that *in vivo* testing for this particular pharmacological activity will be successful. *Cross v. Iizuka*, 753 F.2d 1040, 1050, 224 U.S.P.Q. 739 (Fed. Cir. 1985) (emphasis added).

The *Cross* case is very similar to the present case. Like *in vitro* testing in the pharmaceutical industry, those of skill in the field of biotechnology rely on the reasonable correlation that exists between gene expression and protein expression (see below). Were there no reasonable correlation between the two, the techniques that measure gene levels such as microarray analysis, differential display, and quantitative PCR would not be so widely used by those in the art. As in *Cross*, Applicants here do not argue that there is “an invariable exact correlation” between gene expression and protein expression. Instead, Applicants’ position detailed below is that a measured change in gene expression in cancer cells establishes a “significant probability” that the expression of the encoded polypeptide in cancer will also be changed based on “a reasonable correlation therebetween.”

Taken together, the legal standard for demonstrating utility is a relatively low hurdle. An Applicant need only provide evidence such that it is **more likely than not that a person of skill in the art would be convinced, to a reasonable probability, that the asserted utility is true.** The evidence need not be direct evidence, so long as there is a reasonable correlation between the evidence and the asserted utility. The Applicant **does not need to provide evidence such that it establishes an asserted utility as a matter of statistical certainty.**

Even assuming that the PTO has met its initial burden to offer evidence that one of ordinary skill in the art would reasonably doubt the truth of the asserted utility, Applicants assert that they have met their burden of providing rebuttal evidence such that it is more likely than not those skilled in the art, to a reasonable probability, would believe that the claimed invention is useful as a diagnostic tool for cancer.

Substantial Utility

Summary of Applicants' Arguments and the PTO's Response

In an attempt to clarify Applicants' argument, Applicants offer a summary of their argument and the disputed issues involved. Applicants assert that the claimed polypeptides have utility as diagnostic tools for cancer, particularly esophageal and skin cancer. Applicants' asserted utility rests on the following argument:

1. Applicants have provided reliable evidence that mRNA for the PRO1277 polypeptide is expressed at least two-fold higher in normal esophageal and skin tissue compared to esophageal and melanoma tumor, respectively;

2. Applicants assert that it is well-established in the art that a change in the level of mRNA for a particular protein, e.g. a decrease, generally leads to a corresponding change in the level of the encoded protein, e.g. a decrease;

3. Given Applicants' evidence that the level of mRNA for the PRO1277 polypeptide is decreased in esophageal and melanoma tumor compared to normal esophageal and skin tissue, respectively, it is more likely than not that the PRO1277 polypeptide is decreased in esophageal and melanoma tumor compared to normal esophageal and skin tissue, respectively. Polypeptides such as PRO1277 which are differentially expressed in certain cancers are useful as diagnostic tools, alone or in combination with other diagnostic tools.

Applicants understand the PTO to be making several arguments in response to Applicants' asserted utility:

1. The PTO has challenged the reliability of the evidence reported in Example 18, stating that there is no guidance in the specification as to how high the expression levels are (quantitative), and that there is no indication of the nature or the number of samples that were used in the determining the expression levels;

2. The PTO cites Hu *et al.* to support its assertion that the literature cautions against drawing conclusions based on small changes in transcript expression levels between normal and cancerous tissue;

3. The PTO cites Haynes *et al.* and Chen *et al.* to support its assertion that polypeptide levels cannot be accurately predicted from mRNA levels. Therefore, further research needs to be

Appl. No. : 10/063,538
Filed : May 2, 2002

done to determine if the increase or decrease in PRO1277 cDNA expression supports a role for the peptide in cancerous tissue.

As detailed below, Applicants submit that the PTO has failed to demonstrate that this is one of the “rare cases” where the applicants have “asserted a utility that could only be true if it violated a scientific principle, such as the second law of thermodynamics, or a law of nature, or was wholly inconsistent with contemporary knowledge in the art.” M.P.E.P. § 2107.02 III B. In addition, Applicants submit that the PTO has failed to meet its initial burden to offer evidence “that one of ordinary skill in the art would reasonably doubt the asserted utility.” *In re Brana*, 51 F.3d 1560, 1566, 34 U.S.P.Q.2d 1436 (Fed. Cir. 1995). First, the PTO has failed to offer any evidence to support its rejection of the data in Example 18 and the Declaration of Chris Grimaldi in support of these data. Second, Hu *et al.* is not contrary to Applicants’ asserted utility and does not support the PTO’s position. Third, Applicants submit that given the well-established correlation between a change in the level of mRNA and a corresponding change in the levels of the encoded protein, the PRO1277 protein is likely differentially expressed in certain tumors. Finally, even if the PTO has met its initial burden, Applicants have submitted enough rebuttal evidence such that it is **more likely than not** that a person of skill in the art would be convinced, **to a reasonable probability**, that the asserted utility is true. As stated above, Applicants’ evidence need not be direct evidence, so long as there is a reasonable correlation between the evidence and the asserted utility. **The standard is not absolute certainty.**

Applicants have established that the Gene Encoding the PRO1277 Polypeptide is Differentially Expressed in Certain Cancers compared to Normal Tissue

Applicants first address the PTO’s argument the evidence of differential expression of the gene encoding the PRO1277 polypeptide in esophageal and melanoma tumors is insufficient because there is no guidance in the specification as to how high the expression levels are (quantitative), and there is no indication of the nature or the number of samples that were used in the determining the expression levels. Applicants submit that the gene expression data provided in Example 18 of the present application are sufficient to establish that the PRO1277 gene is differentially expressed in esophageal and melanoma tumors.

Appl. No. : 10/063,538
Filed : May 2, 2002

The gene expression data in the specification, Example 18, shows that the mRNA associated with protein PRO1277 was more highly expressed in esophageal tumor and normal skin versus normal rectum and melanoma tumor. Gene expression was analyzed using standard semi-quantitative PCR amplification reactions of cDNA libraries isolated from different human tumor and normal human tissue samples. Identification of the differential expression of the PRO1277 polypeptide-encoding gene in tumor tissue compared to the corresponding normal tissue renders the molecule useful as a diagnostic tool for the determination of the presence or absence of tumor. Applicants previously submitted a first Declaration of J. Christopher Grimaldi, an expert in the field of cancer biology. This declaration explains the importance of the data in Example 18, and how differential gene and protein expression studies are used to differentiate between normal and tumor tissue (see Declaration, paragraph 7).

In paragraph 5 of his declaration, Mr. Grimaldi states that the gene expression studies reported in Example 18 of the instant application were made from pooled samples of normal and of tumor tissues. Contrary to the PTO's assertions that this makes the data unreliable, Mr. Grimaldi explains that:

The DNA libraries used in the gene expression studies were made from pooled samples of normal and of tumor tissues. *Data from pooled samples is more likely to be accurate than data obtained from a sample from a single individual.* That is, the detection of variations in gene expression is likely to represent a more generally relevant condition when pooled samples from normal tissues are compared with pooled samples from tumors in the same tissue type. (Paragraph 5) (emphasis added).

In paragraphs 6 and 7, Mr. Grimaldi explains that the semi-quantitative analysis employed to generate the data of Example 18 is sufficient to determine if a gene is over- or under-expressed in tumor cells compared to corresponding normal tissue. He states that any visually detectable difference seen between two samples is indicative of at least a two-fold difference in cDNA between the tumor tissue and the counterpart normal tissue. Thus, the results of Example 18 reflect at least a two-fold difference between normal and tumor samples. He also states that the results of the gene expression studies indicate that the genes of interest "can be used to differentiate tumor from normal," thus establishing their reliability. He explains that, contrary to the PTO's assertions, "The precise levels of gene expression are irrelevant; what matters is that there is a relative difference in expression between normal tissue and tumor

Appl. No. : 10/063,538
Filed : May 2, 2002

tissue.” (Paragraph 7). Thus, since it is the relative level of expression between normal tissue and suspected cancerous tissue that is important, the precise level of expression in normal tissue is irrelevant. Likewise, there is no need for quantitative data to compare the level of expression in normal and tumor tissue. As Mr. Grimaldi states, “If a difference is detected, this indicates that the gene and its corresponding polypeptide and antibodies against the polypeptide are useful for diagnostic purposes, to screen samples to differentiate between normal and tumor.”

The PTO has stated that the Grimaldi Declaration is insufficient to overcome the rejection of Claims 1-8 and 11-13, offering two arguments.

First, the PTO states that “there is no data on the PRO1277 polypeptide expression. The specification describes only mRNA expression data. The[re] is no nexus with PRO1277 polypeptide.” Office Action at 13. The PTO also states that “there is no evidentiary art that would corroborate for example, that ‘any visually detectable difference seen between two samples is indicative of at least a two-fold difference in cDNA between the tumor tissue and the counterpart normal tissue.’” Office Action at 13 (quoting first Grimaldi Declaration).

Applicants submit that the declaration of Mr. Grimaldi is based on personal knowledge of the relevant facts at issue. Mr. Grimaldi is an expert in the field and conducted or supervised the experiments at issue. Applicants remind the PTO that “[o]ffice personnel must accept an opinion from a qualified expert that is based upon relevant facts whose accuracy is not being questioned.” PTO Utility Examination Guidelines (2001) (emphasis added). In addition, declarations relating to issues of fact should not be summarily dismissed as “opinions” without an adequate explanation of how the declaration fails to rebut the Examiner’s position. *In re Alton* 76 F.3d 1168 (Fed. Cir. 1996).

While it is true that the specification provides only mRNA expression data, as Applicants explain in detail below, one of skill in the art would accept that increases or decreases in mRNA level for a particular gene are reasonably correlated with increases or decreases in the encoded polypeptide level, respectively. Therefore there is a clear nexus between the differential expression of PRO1277 mRNA in esophageal and melanoma tumors, and the differential expression of the PRO1277 polypeptide.

In addition, Applicants provide herewith as Exhibit 1 a copy of page 122 of the 2002-2003 New England Biolabs catalog. Exhibit 1 shows DNA size markers of differing lengths run

Appl. No. : 10/063,538
Filed : May 2, 2002

on an agarose gel. The column on the left provides the mass of each marker in nanograms and the column on the right provides the length of the marker. It is apparent that the band intensity of markers having mass differences of two-fold are readily distinguishable by eye (*see e.g.*, the difference in band intensities of the 0.1kb fragment present at 61ng and the 0.5kb marker present at 124ng). Accordingly, Applicants maintain that the procedures used to detect differences in expression levels were sufficiently sensitive to detect two-fold differences.

The PTO has not supplied any reasons or evidence to question the accuracy of the facts upon which Mr. Grimaldi based his opinion. Mr. Grimaldi has personal knowledge of the relevant facts, has based his opinion on those facts, and the PTO has offered no reason or evidence to reject either the underlying facts or his opinion. Therefore, the PTO should accept Mr. Grimaldi's opinion with regard to his statement that "any visually detectable difference seen between two samples is indicative of at least a two-fold difference in cDNA between the tumor tissue and the counterpart normal tissue" and that the nucleic acids of interest "can be used to differentiate tumor from normal." Together, these statements establish that there is at least a two-fold difference in expression, and that the results are reliable enough that they can be used to distinguish tumor from normal tissue.

Second, the PTO cites Hu *et al.* (J. Proteome Res., 2(4):405-12 (2003)) for support for its assertion the literature cautions researchers from drawing conclusions based on small changes in transcript expression levels between normal and cancerous tissue. Office Action at 13. The PTO states that Hu teaches that not all genes with increased expression in cancer have a known or published role in cancer.

In Hu, the researchers used an automated literature-mining tool to summarize and estimate the relative strengths of all human gene-disease relationships published on Medline. They then generated a microarray expression dataset comparing breast cancer and normal breast tissue. Using their data-mining tool, they looked for a correlation between the strength of the literature association between the gene and breast cancer, and the magnitude of the difference in expression level. They report that for genes displaying a 5-fold change or less in tumors compared to normal, there was no evidence of a correlation between altered gene expression and a *known* role in the disease. *See* Hu at 411. However, among genes with a 10-fold or more change in expression level, there was a strong correlation between expression level and a

published role in the disease. *Id.* at 412. Importantly, Hu reports that the observed correlation was only found among estrogen receptor-positive tumors, not ER-negative tumors. *Id.*

The general findings of Hu are not surprising – one would expect that genes with the greatest change in expression in a disease would be the first targets of research, and therefore have the strongest known relationship to the disease as measured by the number of publications reporting a connection with the disease. The correlation reported in Hu only indicates that the greater the change in expression level, the more likely it is that there is a *published* or *known* role for the gene in the disease, as found by their automated literature-mining software. Thus, Hu's results merely reflect a bias in the literature toward studying the most prominent targets, and reflect nothing regarding the ability of a gene that is 2-fold or more differentially expressed in tumors to serve as a disease marker.

Hu acknowledges the shortcomings of this method in explaining the disparity in Hu's findings for ER-negative versus ER-positive tumors: Hu attributes the "bias in the literature" toward the more prevalent ER-positive tumors as the explanation for the lack of any correlation between number of publications and gene expression levels in less-prevalent (and, therefore, less studied) ER-negative tumors. *Id.* Because of this intrinsic bias, Hu's methodology is unlikely to ever note a correlation of a disease with less differentially-expressed genes and their corresponding proteins, regardless of whether or not an actual relationship between the disease and less differentially-expressed genes exists. Accordingly, Hu's methodology yields results that provide little or no information regarding biological significance of genes with less than 5-fold expression change in disease.

The correlation reported in Hu only indicates that the greater the change in expression level, the more likely it is that there is a *published* or *known* role for the gene in the disease, as found by their automated literature-mining software. Nowhere in Hu does it say that a lack of correlation in their study means that genes with a less than five-fold change in level of expression in cancer cannot serve as a molecular marker of cancer.

Applicants submit that a lack of known role for PRO1277 in cancer does not prevent its use as a diagnostic tool for cancer. There is a difference between use of a gene for distinguishing between tumor and normal tissue on the one hand, and establishing a role for the gene in cancer on the other. Genes with lower levels of change in expression may or may not be the most

Appl. No. : 10/063,538
Filed : May 2, 2002

important genes in causing the disease, but the genes can still show a consistent and measurable change in expression. While such genes may or may not be good targets for further research, they can nonetheless be used as diagnostic tools. Thus, Hu does not refute the Applicants' assertion that the PRO1277 gene can be used as a cancer diagnostic tool because it is differentially expressed in certain tumors.

In conclusion, Applicants submit that the evidence reported in Example 18, combined with the first Grimaldi Declaration, establish that there is at least a two-fold difference in PRO1277 cDNA between esophageal and melanoma tumor tissue and the normal esophageal and skin tissue, respectively. Therefore, it follows that expression levels of the PRO1277 gene can be used to distinguish esophageal and melanoma tumor tissue from normal esophageal and skin tissue, respectively. The PTO has not offered any significant arguments or evidence to the contrary. As Applicants explain below, it is more likely than not that the PRO1277 polypeptide can also be used to distinguish esophageal and melanoma tumor tissue from normal esophageal and skin tissue, respectively.

Applicants have established that the Accepted Understanding in the Art is that there is a Positive Correlation between mRNA Levels and the Level of Expression of the Encoded Protein

Applicants next turn to the second portion of their argument in support of their asserted utility – that it is well-established in the art that a change in the level of mRNA for a particular protein, generally leads to a corresponding change in the level of the encoded protein; given Applicants' evidence that of differential expression of the mRNA for the PRO1277 polypeptide in esophageal and melanoma tumor, it is likely that the PRO1277 polypeptide is differentially expressed; and proteins differentially expressed in certain tumors have utility as diagnostic tools.

In response to Applicants' assertion, the PTO cites Haynes *et al.* (Electrophoresis, 19(11):1862-71 (1998)) and Chen *et al.* (Mol. and Cell. Proteomics, 1:304-313 (2002)) as support for its argument that "polypeptide levels cannot be accurately predicted from mRNA levels." Office Action at 5-6. For the reasons discussed below, Haynes and Chen are not contrary to Applicants' asserted utility.

Haynes studied whether there is a correlation between the level of mRNA expression and the level of protein expression for 80 selected genes from yeast. The genes were selected

Appl. No. : 10/063,538
Filed : May 2, 2002

because they constituted a relatively homogeneous group with respect to predicted half-life and expression level of the protein products. *See* Haynes at 1863. Haynes did not examine whether a change in transcript level for a particular gene led to a change in the level of expression of the corresponding protein. Instead, Haynes determined whether the steady-state transcript level correlated with the steady-state level of the corresponding protein based on an analysis of 80 different genes.

Haynes reported to have “found a general trend but no strong correlation between protein and transcript levels.” *Id.* However, a cursory inspection of Fig. 1 shows a clear correlation between the mRNA levels and protein levels measured. This correlation is confirmed by an inspection of the full-length research paper from which the data in Fig. 1 were derived, presented herein as Exhibit 2 (Gygi *et al.*, Molecular and Cellular Biology, Mar. 1999, 1720-1730). Gygi states that “there was a general trend of increased protein levels resulting from increased mRNA levels,” with a correlation coefficient of 0.935, indicating a strong correlation. Gygi at 1726. Moreover, Gygi also states that the correlation is especially strong for highly expressed mRNAs. *Id.* Thus, it is not clear that Haynes even supports the Examiner’s position, as Haynes did report a general trend, and Gygi reports a strong correlation between increasing mRNA levels and increasing protein levels.

The PTO focuses on the portion of Haynes where the authors reported that for some of the studied genes with equivalent mRNA levels, there were differences in corresponding protein expression, including some that varied by more than 50-fold. Similarly, Haynes reports that different proteins with similar expression levels were maintained by transcript levels that varied by as much as 40-fold. *Id.* Thus, Haynes showed that for one type of yeast, similar mRNA levels for *different* genes did not universally result in equivalent protein levels for the *different* gene products, and similar protein levels for *different* gene products did not universally result from equivalent mRNA levels for the *different* genes. These results are expected, since there are many factors that determine translation efficiency for a given transcript, or the half-life of the encoded protein. Not surprisingly, based on these results, Haynes concluded that protein levels cannot always be accurately predicted from the level of the corresponding mRNA transcript *when looking at the level of transcripts across different genes.*

Appl. No. : 10/063,538
Filed : May 2, 2002

Importantly, Haynes did not say that for a single gene, the level of mRNA transcript is not positively correlated with the level of protein expression. Applicants have asserted that increasing or decreasing the level of mRNA for the same gene leads to a increase or decrease for the corresponding protein. Haynes did not study this issue and says absolutely nothing about it. Therefore, Haynes is not inconsistent with or contradictory to the utility of the instant claims, and offers no support for the PTO's position.

The PTO also cites Chen *et al.* for support for the assertion that polypeptide levels cannot be accurately predicted from mRNA levels. In Chen, the authors examined the relationship between mRNA levels and protein levels in 76 lung adenocarcinomas and 9 non-tumor lung samples. Like Haynes, Chen examined the global relationship between mRNA and the corresponding protein abundance by calculating the average mRNA and protein level of all the samples for each gene or protein, and then looked for a correlation across different genes. As discussed above with respect to Haynes, this measurement of a correlation across genes is not relevant to Applicants' asserted utility. Chen also looked at the level of mRNA of 98 individual genes and their corresponding proteins across the samples. Chen reports that 21.4% (21 of 98) of the genes showed a statistically significant correlation between protein and mRNA expression.

Chen provides scant evidence to counter Applicants' asserted utility for the claimed antibodies because portions of Chen support Applicants' assertions, and the remaining portions provide little insight into the relationship between mRNA levels and corresponding protein levels for mRNA that is differentially expressed in tumor cells relative to normal cells. Rather than looking for mRNAs which were differentially expressed, Chen merely selected proteins whose identity could be determined regardless of any changes in expression level (Chen at 306, right column). Importantly, it is not known if there was any substantial difference in mRNA levels for the various genes across samples – in short, with the exception of the genes in Figures 2A-2C, it is not known if the genes examined were differentially expressed. Also of significance for Applicants' asserted utility is the fact that Chen did not attempt to examine any differential expression between the cancerous lung samples and the non-cancerous lung samples – Chen did not distinguish between cancer and normal samples in their analysis.

Applicants have asserted that changes in mRNA levels, particularly those which are two-fold or greater, will correspond with measurable changes in polypeptide expression. The data in

Chen support Applicants' assertion. In Figures 2A-2C, Chen plots mRNA value vs. protein value for three genes. In these figures, a wide range of mRNA expression levels were observed (approximately seven- to eight-fold), and a correlation between mRNA and protein levels was observed for all three mRNA/protein pairs. This supports Applicants' asserted correlation between changes in mRNA levels which are two-fold or greater and changes in polypeptide expression.

The PTO relies on the fact that Chen also reports a lack of correlation for some mRNA/protein pairs to support its assertion that polypeptide levels cannot be accurately predicted from mRNA levels. However, the lack of correlation reported by Chen could be a result of a lack of substantial changes in mRNA level. This can be understood by again turning to Figures 2A-2C. As noted above, where a wide range of mRNA expression levels are seen, a correlation between mRNA and protein levels was observed. However, if one examines the data points within a small range of mRNA levels for these same genes, e.g. 500-600 or 5000-6000 in Figs. 2A-2C, it is clear that a correlation would not be detected for the data within this range. This does not mean that a correlation between changes in mRNA and protein does not exist for these genes, as is evident when larger changes in mRNA expression are included in the analysis. Instead, this indicates that for relatively small changes in mRNA, any correlation is masked by imprecision in the measurements.

Chen's experiment compared mRNA levels vs. protein levels across samples without selecting mRNA that showed a difference in expression level. And unlike Applicants, Chen did not examine differences in mRNA between tumor and normal tissue. Since almost all samples tested by Chen were from the same type of tissue, few substantial variations in the level of mRNA or protein for a particular gene across the samples tested would be expected. Instead, it would be expected that most genes examined by Chen would have similar mRNA or protein levels across the samples. Figures 2A-2C of Chen demonstrate that the methods utilized by Chen cannot detect correlations between mRNA and protein levels when only small differences in mRNA expression are observed, but a correlation is detected when larger differences in mRNA expression are observed.

Accordingly, the only data reported by Chen which shows substantial changes in the expression of mRNA, Figures 2A-C, confirms Applicants' assertion that substantial changes in

Appl. No. : 10/063,538
Filed : May 2, 2002

mRNA levels (e.g., 2-fold or greater) will correspond to substantial changes in polypeptide expression. Further, this data also explains the lack of observed correlation between mRNA levels and protein levels for other genes reported by Chen. Thus, even given Chen's inability to detect a correlation between mRNA and protein in some genes, Chen's results do not refute Applicants' position.

Instead, Chen supports Applicants' position that a significant correlation between mRNA and protein levels exists for changes in mRNA levels that are 2-fold or greater. In further support of Applicants' position, Chen cites Celis *et al.* (FEBS Lett., 480:2-16 (2000)) stating that the authors "found a good correlation between transcript and protein levels among 40 well resolved, abundant proteins using a proteomic and microarray study of bladder cancer." *Chen* at 311, first column (emphasis added). As mentioned above, the lack of a correlation across genes is not relevant to Applicants' asserted utility, and therefore Chen's discussion of this issue and citation of Anderson and Seilhamer (Electrophoresis, 18:533-37 (1997)) and Gygi *et al.* (Mol. Cell. Bio., 19:1720-30 (1999)) offer no support for the PTO's position.

Even if the results in Chen supported the PTO's argument, which they do not as discussed above, one contrary example does not establish that one of skill in the art would find it is more likely than not there is no general correlation between changes in mRNA level and changes in protein level for an individual gene. There are other non-transcriptional mechanisms for regulating gene and protein expression (*i.e.*, post-transcriptional regulation of genes, translation efficiency, etc.). However, as shown by the declarations, references, and textbooks discussed below, Applicants submit that the understanding in the art is that generally there is a correlation between a change in mRNA level and a change in protein level. In fact, the working hypothesis among those skilled in the art, as illustrated by the evidence presented by Applicants, is that there is a positive correlation between changes in mRNA levels and changes in protein levels for a particular gene.

In support of the assertion that changes in mRNA are positively correlated to changes in protein levels, Applicants previously submitted a copy of a second Declaration by J. Christopher Grimaldi, an expert in the field of cancer biology (previously attached as Exhibit 6). As stated in paragraph 5 of the declaration, "Those who work in this field are well aware that in the vast majority of cases, when a gene is over-expressed...the gene product or polypeptide will also be

Appl. No. : 10/063,538
Filed : May 2, 2002

over-expressed.... This same principal applies to gene under-expression.” Further, “the detection of increased mRNA expression is expected to result in increased polypeptide expression, and the detection of decreased mRNA expression is expected to result in decreased polypeptide expression. The detection of increased or decreased polypeptide expression can be used for cancer diagnosis and treatment.” The references cited in the declaration and submitted herewith support this statement.

Applicants also previously submitted a copy of the declaration of Paul Polakis, Ph.D. (previously attached as Exhibit 7), an expert in the field of cancer biology. As stated in paragraph 6 of his declaration:

Based on my own experience accumulated in more than 20 years of research, including the data discussed in paragraphs 4 and 5 above [showing a positive correlation between mRNA levels and encoded protein levels in the vast majority of cases] and my knowledge of the relevant scientific literature, it is my considered scientific opinion that for human genes, an increased level of mRNA in a tumor cell relative to a normal cell typically correlates to a similar increase in abundance of the encoded protein in the tumor cell relative to the normal cell. In fact, *it remains a central dogma in molecular biology that increased mRNA levels are predictive of corresponding increased levels of the encoded protein.* (Emphasis added).

Dr. Polakis acknowledges that there are published cases where such a correlation does not exist, but states that it is his opinion, based on over 20 years of scientific research, that “such reports are exceptions to the commonly understood general rule that increased mRNA levels are predictive of corresponding increased levels of the encoded protein.” (Polakis Declaration, paragraph 6).

The statements of Grimaldi and Polakis are supported by the teachings in Molecular Biology of the Cell, a leading textbook in the field (Bruce Alberts, *et al.*, Molecular Biology of the Cell (3rd ed. 1994) (submitted herewith as Exhibit 3) and (4th ed. 2002) (submitted herewith as Exhibit 4)). Figure 9-2 of Exhibit 3 shows the steps at which eukaryotic gene expression can be controlled. The first step depicted is transcriptional control. Exhibit 3 provides that “[f]or most genes transcriptional controls are paramount. This makes sense because, of all the possible control points illustrated in Figure 9-2, only transcriptional control ensures that no superfluous intermediates are synthesized.” Exhibit 3 at 403 (emphasis added). In addition, the text states that “Although controls on the initiation of gene transcription are the predominant form of

regulation for most genes, other controls can act later in the pathway from RNA to protein to modulate the amount of gene product that is made.” Exhibit 3 at 453 (emphasis added). Thus, as established in Exhibit 3, the predominant mechanism for regulating the amount of protein produced is by regulating transcription initiation.

In Exhibit 4, Figure 6-3 on page 302 illustrates the basic principle that there is a correlation between increased gene expression and increased protein expression. The accompanying text states that “a cell can change (or regulate) the expression of each of its genes according to the needs of the moment – *most obviously by controlling the production of its mRNA.*” Exhibit 4 at 302 (emphasis added). Similarly, Figure 6-90 on page 364 of Exhibit 4 illustrates the path from gene to protein. The accompanying text states that while potentially each step can be regulated by the cell, “the initiation of transcription is the most common point for a cell to regulate the expression of each of its genes.” Exhibit 4 at 364 (emphasis added). This point is repeated on page 379, where the authors state that of all the possible points for regulating protein expression, “[f]or most genes transcriptional controls are paramount.” Exhibit 4 at 379 (emphasis added).

Further support for Applicants’ position can be found in the textbook, *Genes VI*, (Benjamin Lewin, *Genes VI* (1997)) (submitted herewith as Exhibit 5) which states “having acknowledged that control of gene expression can occur at multiple stages, and that production of RNA cannot inevitably be equated with production of protein, it is clear that the overwhelming majority of regulatory events occur at the initiation of transcription.” *Genes VI* at 847-848 (emphasis added).

Additional support is also found in Zhigang *et al.*, *World Journal of Surgical Oncology* 2:13, 2004, submitted herewith as Exhibit 6. Zhigang studied the expression of prostate stem cell antigen (PSCA) protein and mRNA to validate it as a potential molecular target for diagnosis and treatment of human prostate cancer. The data showed “a high degree of correlation between PSCA protein and mRNA expression” Exhibit 6 at 4. Of the samples tested, 81 out of 87 showed a high degree of correlation between mRNA expression and protein expression. The authors conclude that “it is demonstrated that PSCA protein and mRNA overexpressed in human prostate cancer, and that the increased protein level of PSCA was resulted from the upregulated transcription of its mRNA.” Exhibit 6 at 6. Even though the correlation between mRNA

Appl. No. : 10/063,538
Filed : May 2, 2002

expression and protein expression occurred in 93% of the samples tested, not 100%, the authors state that "PSCA may be a promising molecular marker for the clinical prognosis of human Pca and a valuable target for diagnosis and therapy of this tumor." Exhibit 6 at 7.

Further, Meric *et al.*, Molecular Cancer Therapeutics, vol. 1, 971-979 (2002), submitted herewith as Exhibit 7, states the following:

The **fundamental principle** of molecular therapeutics in cancer is to exploit the differences in gene expression between cancer cells and normal cells...[M]ost efforts have concentrated on identifying differences in gene expression at the level of mRNA, which can be attributable to either DNA amplification or to differences in transcription. Meric *et al.* at 971 (emphasis added).

Those of skill in the art would not be focusing on differences in gene expression between cancer cells and normal cells if there were no correlation between gene expression and protein expression.

Together, the declarations of Grimaldi and Polakis, the accompanying references, and the excerpts and references provided above all establish that the accepted understanding in the art is that there is a reasonable correlation between changes in gene expression and the level of the encoded protein.

In response to the Polakis Declaration, the PTO states that "Only Dr. Polakis' conclusions are provided in the declaration. There is no evidence to support Dr. Polakis' statement that it remains a central dogma in molecular biology that increased mRNA levels are predictive of corresponding increased levels of the encoded polypeptide." Office Action at 10.

Applicants' note that in paragraphs 4 and 5 of Dr. Polakis' declaration, he describes the identification of approximately 200 gene transcripts that are more highly expressed in human tumor cells than in the corresponding normal tissue. The corresponding protein level of about 30 of those transcripts have been investigated in the same tissues. Dr. Polakis reports that "[i]n approximately 80% of our observations we have found that increases in the level of a particular mRNA correlates with changes in the level of protein expressed from that mRNA when human tumor cells are compared with their corresponding normal cells." Polakis Declaration, paragraph 5. This evidence clearly supports his assertion it increased mRNA levels are predictive of corresponding increased levels of the encoded polypeptide.

The PTO also makes the following arguments in response to the Polakis declaration:

Appl. No. : 10/063,538
Filed : May 2, 2002

Although, Dr. Polakis states that it remains a central dogma in molecular biology that increased mRNA levels are predictive of corresponding increased levels of the encoded polypeptide, it is important to note that the instant specification provides no information regarding differential mRNA levels of PRO1277 in tumor samples as contrasted to normal tissue samples or the corresponding protein levels. Only mRNA expression data is presented. Therefore, the declaration is insufficient to overcome the rejection of claims 1-8 and 11-13 based upon 35 U.S.C. § 101 and 112, first paragraph, since it is limited to a discussion of data regarding the correlation of mRNA levels and polypeptide levels. Furthermore, the declarations do not provide data such that the examiner can independently draw conclusions. Office Action at 14 (emphasis added).

Applicants are unsure how to respond to this argument. First, Applicants note that Example 18 does provide “information regarding differential mRNA levels of PRO1277 in tumor samples as contrasted to normal tissue samples.” Example 18 reports mRNA expression levels as measured by examining cDNA libraries comparing normal and tumor tissues. Second, the fact that the Polakis declaration is a discussion of data regarding the correlation of mRNA levels and polypeptide levels is not a reason to reject the declaration. Rather, Dr. Polakis’ declaration is extremely relevant as it directly supports Applicants’ assertion that changes in mRNA level can be used to assess changes in protein level. Finally, as indicated above, Dr. Polakis does offer evidence to support his assertion that increased mRNA levels are predictive of corresponding increased levels of the encoded polypeptide. He states that approximately 80% of the gene transcripts he has studied in the course of developing the currently claimed invention show a correlation between changes in mRNA and changes in the level of the encoded polypeptide. In addition, Applicants’ have supplied numerous references which support Dr. Polakis’ statements. The PTO’s arguments rejecting Dr. Polakis’ declaration are therefore misplaced.

Applicants remind the PTO that “[o]ffice personnel must accept an opinion from a qualified expert that is based upon relevant facts whose accuracy is not being questioned.” PTO Utility Examination Guidelines (2001) (emphasis added). In addition, declarations relating to issues of fact should not be summarily dismissed as “opinions” without an adequate explanation of how the declaration fails to rebut the Examiner’s position. *In re Alton* 76 F.3d 1168 (Fed. Cir. 1996).

Finally, Applicants address the PTO’s argument that further research needs to be done to determine whether the increase of decrease of PRO1277 DNA supports a role for the peptide in

Appl. No. : 10/063,538
Filed : May 2, 2002

the cancerous tissue, and that such a role has not been suggested by the instant disclosure. *See* Office Action at 6-7.

Applicants submit that a lack of known role for PRO1277 in cancer does not prevent its use as a diagnostic tool for cancer. The fact that there is no known translocation or mutation of PRO1277, for example, is irrelevant to whether its differential expression can be used to assist in diagnosis of cancer – one does not need to know why PRO1277 is differentially expressed, or what the consequence of the differential expression is, in order to exploit the differential expression to distinguish tumor from normal tissue.

In fact the Revised Interim Utility Guidelines promulgated by the PTO recognize that proteins which are differentially expressed in cancer have utility. The caveat in Example 12 states that the utility requirement is satisfied where a protein is expressed on melanoma cells but not on normal skin, and that antibodies against the protein can be used to diagnose cancer. The position of the PTO requiring a known role for PRO1277 in cancer for utility is also inconsistent with the analogous standard for therapeutic utility of a compound where “the mere identification of a pharmacological activity of a compound that is relevant to an asserted pharmacological use provides an ‘immediate benefit to the public’ and thus satisfies the utility requirement.” M.P.E.P. §2701.01 (emphasis original). Here, the mere identification of altered expression in tumors is relevant to diagnosis of tumors, and, therefore, provides an immediate benefit to the public.

In addition, while Applicants appreciate that actions taken in other applications are not binding on the PTO with respect to the present application, Applicants note that the PTO has issued several patents claiming differentially expressed polypeptides and antibodies to the same, or methods employing such antibodies. (*See, e.g.*, U.S. Patent No. 6,414,117, U.S. Patent No. 6,124,433, U.S. Patent No. 6,156,500, and U.S. Patent No. 6,562,343 attached hereto as Exhibits 8-11.)

Accordingly, Applicants submit that they have offered sufficient evidence to establish that it is more likely than not that one of skill in the art would believe that because the PRO1277 mRNA is more highly expressed in normal esophageal and skin tissue compared to esophageal and melanoma tumor, respectively, the PRO1277 polypeptide will also be more highly expressed in normal esophageal and skin tissue compared to esophageal and melanoma tumor, respectively.

Appl. No. : 10/063,538
Filed : May 2, 2002

This differential expression of PRO1277 and related polypeptides make them useful as diagnostic tools for cancer.

The Arguments made by the PTO are Not Sufficient to satisfy the PTO's Initial Burden of Offering Evidence "that one of ordinary skill in the art would reasonably doubt the asserted utility"

As stated above, an Applicant's assertion of utility creates a presumption of utility that will be sufficient to satisfy the utility requirement of 35 U.S.C. § 101, "unless there is a reason for one skilled in the art to question the objective truth of the statement of utility or its scope." *In re Langer*, 503 F.2d 1380, 1391, 183 USPQ 288, 297 (CCPA 1974). The evidentiary standard to be used throughout *ex parte* examination in setting forth a rejection is a preponderance of the evidence, or "more likely than not" standard. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). This is stated explicitly in the M.P.E.P.:

[T]he applicant does not have to provide evidence sufficient to establish that an asserted utility is true "beyond a reasonable doubt." **Nor must the applicant provide evidence such that it establishes an asserted utility as a matter of statistical certainty.** Instead, evidence will be sufficient if, considered as a whole, it leads a person of ordinary skill in the art to conclude that the asserted utility is more likely than not. M.P.E.P. at § 2107.02, part VII (2004) (underline emphasis in original, bold emphasis added, internal citations omitted).

The PTO has the initial burden to offer evidence "that one of ordinary skill in the art would reasonably doubt the asserted utility." *In re Brana*, 51 F.3d 1560, 1566, 34 U.S.P.Q.2d 1436 (Fed. Cir. 1995). Only then does the burden shift to the Applicant to provide rebuttal evidence. *Id.* As stated in the M.P.E.P., such rebuttal evidence does not need to absolutely prove that the asserted utility is real. Rather, the evidence only needs to be reasonably indicative of the asserted utility.

Applicants remind the PTO that the M.P.E.P. cautions that rejections for lack of utility are rarely sustained by federal courts, and that generally speaking, a utility rejection was sustained because the applicant asserted a utility "that could **only be true if it violated a scientific principle, such as the second law of thermodynamics, or a law of nature, or was wholly inconsistent with contemporary knowledge in the art.**" M.P.E.P. § 2107.02 III B., citing *In re Gazave*, 379 F.2d 973, 978, 154 U.S.P.Q. 92, 96 (CCPA 1967) (underline emphasis

Appl. No. : 10/063,538
Filed : May 2, 2002

in original, bold emphasis added). Rather than being wholly inconsistent with contemporary knowledge in the art, Applicants' asserted utility is squarely within the teaching of leading textbooks in the field, and is supported by references and the declarations of skilled experts.

The PTO has not offered any arguments or cited any references to establish "that one of ordinary skill in the art would reasonably doubt" that a polypeptide differentially expressed in certain tumors can be used as a diagnostic tool. As stated previously, Sen *et al.* and Pennica *et al.* are irrelevant to the utility of the claimed polypeptides as Example 18 reports gene expression data, not gene amplification data. Likewise, Hu *et al.*, Haynes *et al.*, and Chen *et al.* do not support the PTO's position and are not contrary to Applicants' asserted utility. Given the lack of support for the PTO's position, Applicants submit that the PTO has not met its initial burden of overcoming the presumption that the asserted utility is sufficient to satisfy the utility requirement. And even if the PTO has met that burden, the Applicants' supporting rebuttal evidence is sufficient to establish that one of skill in the art would be more likely than not to believe that the claimed polypeptides can be used as diagnostic tools for cancer, particularly esophageal and melanoma tumors.

Specific Utility

The Asserted Substantial Utilities are Specific to the Claimed Polypeptides

Applicants next address the PTO's assertion that the asserted utilities are not specific to the claimed polypeptides related to PRO1277. Applicants respectfully disagree.

Specific Utility is defined as utility which is "specific to the subject matter claimed," in contrast to "a general utility that would be applicable to the broad class of the invention." M.P.E.P. § 2107.01 I. Applicants submit that the evidence of differential expression of the PRO1277 gene and polypeptide in certain types of tumor cells, along with the declarations and references discussed above, provide a specific utility for the claimed polypeptides.

As discussed above, there are significant data which show that the gene for the PRO1277 polypeptide is expressed at least two-fold higher in normal esophageal and skin tissue compared to esophageal and melanoma tumor, respectively. These data are strong evidence that the PRO1277 gene and polypeptide are associated with esophageal and melanoma tumors. Thus, contrary to the assertions of the PTO, Applicants submit that they have provided evidence

Appl. No. : 10/063,538
Filed : May 2, 2002

associating the PRO1277 gene and polypeptide with a specific disease. The asserted utility for the claimed polypeptides as diagnostic tools for cancer, particularly esophageal and melanoma tumor, is a specific utility – it is not a general utility that would apply to the broad class of polypeptides.

Conclusion

The PTO has asserted three arguments to support its conclusion that based on the cited literature, one of skill in the art would not assume that the increase in gene amplification of PRO1277 would correlate with increased mRNA or polypeptide levels: (1.) the PTO has challenged the reliability of the evidence reported in Example 18; (2.) the PTO cites Hu *et al.* to support its assertion that the literature cautions against drawing conclusions based on small changes in transcript expression levels between normal and cancerous tissue; and, (3.) the PTO cites Haynes *et al.* and Chen *et al.* to support its assertion that polypeptide levels cannot be accurately predicted from mRNA levels. The PTO states that further research is needed to determine if the increase or decrease in PRO1277 cDNA expression supports a role for the peptide in cancerous tissue. Applicants have addressed each of these arguments in turn.

First, the Applicants provided a first Declaration of Chris Grimaldi stating that the gene expression data in Example 18 are real and significant. This declaration also indicates that given the relative difference of at least two-fold in expression levels, the disclosed nucleic acids and corresponding polypeptides have utility as cancer diagnostic tools.

Second, Hu *et al.* does not support the PTO's position, and is not contrary to Applicants' asserted utility. Third, Applicants have shown that the second Grimaldi Declaration and Polakis Declaration, the accompanying references, as well as the excerpts and references cited above, demonstrate that it is well-established in the art that a change in mRNA levels generally correlates to a corresponding change in protein levels. Haynes *et al.* does not address this issue, and Chen *et al.* is not contrary to Applicants' asserted utility. Thus, the PTO has not offered any substantial reason or evidence to question these declarations and supporting references.

Third, Applicants have shown that it is not necessary to know what role PRO1277 plays in cancer to use it as a diagnostic tool. The PTO's own guidelines recognize this fact, and

Appl. No. : 10/063,538
Filed : May 2, 2002

numerous patents have issued which claim differentially expressed polypeptides and antibodies to the same, or methods employing such antibodies.

Finally, the PTO asserts that there is no asserted specific utility. Applicants have pointed out that the substantial utilities described above are specific to the claimed polypeptides because the PRO1277 gene and polypeptide are differentially expressed in certain cancer cells compared to the corresponding normal cells. This is not a general utility that would apply to the broad class of polypeptides.

Given the totality of the evidence provided, Applicants submit that they have established a substantial, specific, and credible utility for the claimed polypeptides as diagnostic tools. According to the PTO Utility Examination Guidelines (2001), irrefutable proof of a claimed utility is not required. Rather, a specific, substantial, and credible utility requires only a “reasonable” confirmation of a real world context of use. Applicants remind the PTO that:

A small degree of utility is sufficient . . . The claimed invention must only be capable of performing some beneficial function . . . An invention does not lack utility merely because the particular embodiment disclosed in the patent lacks perfection or performs crudely . . . A commercially successful product is not required . . . Nor is it essential that the invention accomplish all its intended functions . . . or operate under all conditions . . . partial success being sufficient to demonstrate patentable utility . . . In short, **the defense of non-utility cannot be sustained without proof of total incapacity**. If an invention is only partially successful in achieving a useful result, a rejection of the claimed invention as a whole based on a lack of utility is not appropriate. M.P.E.P. at 2107.01 (underline emphasis in original, bold emphasis added, citations omitted).

Applicants submit that they have established that it is more likely than not that one of skill in the art would reasonably accept the utility for the claimed polypeptides relating to PRO1277 set forth in the specification. In view of the above, Applicants respectfully request that the PTO reconsider and withdraw the utility rejection under 35 U.S.C. §101.

Rejections under 35 U.S.C. § 112, first paragraph – Enablement

The PTO also maintains its rejection of Claims 1-13 under 35 U.S.C. § 112, first paragraph. Specifically, the PTO asserts that because the claimed invention is not supported by either a specific or substantial asserted utility or a well established utility, one skilled in the art would not know how to use the claimed invention. Office Action at 3-4.

Appl. No. : 10/063,538
Filed : May 2, 2002

Applicants submit that in the discussion of the 35 U.S.C. § 101 rejection above, Applicants have established a substantial, specific, and credible utility for the claimed polypeptides. Applicants respectfully request that the PTO reconsider and withdraw the enablement rejection under 35 U.S.C. §112.

Rejection under 35 U.S.C. §112, first paragraph – Written Description

The PTO maintains the rejection of Claims 1-5, 12 and 13 under 35 U.S.C. § 112, first paragraph, as failing to satisfy the written description requirement for the reasons set forth in the previous Office Action. Briefly, the PTO asserts the Applicants were not in possession of all or a significant number polypeptides that have 80-99% homology to SEQ ID NO:34 and still retain the function of SEQ ID NO:34.

The Legal Standard for Written Description

The well-established test for sufficiency of support under the written description requirement of 35 U.S.C. §112 , first paragraph is whether the disclosure “reasonably conveys to artisan that the inventor had possession at that time of the later claimed subject matter.” *In re Kaslow*, 707 F.2d 1366, 1375, 2121 USPQ 1089, 1096 (Fed. Cir. 1983); *see also Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116 (Fed. Cir. 1991). The adequacy of written description support is a factual issue and is to be determined on a case-by-case basis. *See e.g., Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116 (Fed. Cir. 1991). The factual determination in a written description analysis depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure. *Union Oil v. Atlantic Richfield Co.*, 208 F.3d 989, 996 (Fed. Cir. 2000).

The Current Invention is Adequately Described

As noted above, whether the Applicants were in possession of the invention as of the effective filing date of an application is a factual determination, reached by the consideration of a number of factors, including the level of knowledge and skill in the art, and the teaching provided by the specification. The inventor is not required to describe every single detail of his/her invention. An Applicant’s disclosure obligation varies according to the art to which the

Appl. No. : 10/063,538
Filed : May 2, 2002

invention pertains. The present invention pertains to the field of recombinant DNA/protein technology. It is well-established that the level of skill in this field is very high since a representative person of skill is generally a Ph.D. scientist with several years of experience. Accordingly, the teaching imparted in the specification must be evaluated through the eyes of a highly skilled artisan as of the date the invention was made.

As amended, the pending claims are related to isolated polypeptides having at least 95% or 99% amino acid sequence identity to several polypeptides related to SEQ ID NO:34, and satisfy the limitation "wherein said isolated polypeptide is more highly expressed in normal esophageal tissue or normal skin compared to esophageal tumor or melanoma tumor respectively, or wherein said isolated polypeptide is encoded by a polynucleotide that is more highly expressed in normal esophageal tissue or normal skin compared to esophageal tumor or melanoma tumor respectively" or "wherein said isolated polypeptide or a fragment thereof can be used to generate an antibody which can be used to specifically detect the polypeptide of SEQ ID NO:34 in esophageal or skin tissue samples."

Applicants maintain that there is no substantial variation within the species which fall within the scope of the amended claims, which require at least 95% or 99% amino acid sequence identity to the disclosed sequences related to SEQ ID NO:34. Applicants note that the pending Claims are analogous to the claims discussed in Example 14 of the written description training materials. In Example 14, the written description requirement was found to be satisfied for claims relating to polypeptides having 95% homology to a particular sequence and possessing a particular catalytic activity, even though the applicant had not made any variants. Similarly, the pending claims also have very high sequence homology to the disclosed sequences and must share the same expression pattern in certain tumors, or share an epitope sufficient to generate antibodies which specifically detect the polypeptide of SEQ ID NO:34 in esophageal or skin tissue samples.

In Example 14, the procedures for making variants were known in the art and the disclosure taught how to test for the claimed catalytic activity. Similarly, in the instant application, it is well known in the art how to make polypeptides with at least 95% amino acid sequence identity to the disclosed sequences. In addition, the specification discloses how to test to determine if the polypeptide or encoding nucleic acid is differentially expressed in esophageal

Appl. No. : 10/063,538
Filed : May 2, 2002

or melanoma tumors, and how to make antibodies which specifically detect the polypeptide of SEQ ID NO:34 in esophageal or skin tissue samples. Like Example 14, the genus of polypeptides that have at least 95% or 99% amino acid sequence identity to the disclosed sequences will not have substantial variation.

Furthermore, while Applicants appreciate that actions taken by the PTO in other applications are not binding with respect to the examination of the present application, Applicants note that the PTO has issued many patents containing claims to variant nucleic acids or variant proteins where the applicants did not actually make such nucleic acids or proteins. Representative patents include U.S. Patent No: 6,737,522, U.S. Patent No. 6,395,306, U.S. Patent No. 6,025,156, U.S. Patent No. 6,645,499, U.S. Patent No. 6,498,235, and U.S. Patent No. 6,730,502 which are attached hereto as Exhibits 12-17.

In conclusion, Applicants submit that they have satisfied the written description requirement for the pending claims based on the actual reduction to practice of SEQ ID NO:34, by specifying a high level of amino acid sequence identity, by describing how to test for differential expression of the polypeptide and encoding nucleic acid, and by describing how to make antibodies to the disclosed sequence, all of which result in a lack of substantial variability in the species falling within the scope of the instant claims. Applicants submit that this disclosure would allow one of skill in the art to "recognize that the applicant was in possession of the necessary common attributes or features of the elements possessed by the members of the genus." Hence, Applicants respectfully request that the PTO reconsider and withdraw the written description rejection under 35 U.S.C. §112.

Appl. No. : 10/063,538
Filed : May 2, 2002

CONCLUSION

In view of the above, Applicants respectfully maintain that claims are patentable and request that they be passed to issue. Applicants invite the Examiner to call the undersigned if any remaining issues may be resolved by telephone.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: June 29, 2005

By: AnneMarie Kaiser

AnneMarie Kaiser
Registration No. 37,649
Attorney of Record
Customer No. 30,313
(619) 235-8550

1739987
060205